REMARKS

Claims 16-31

Claims 16-31 have been rejected under 35 USC 101 as being in improper form for a computer program product. Claims 16 and 31 have been amended in a manner believed to obviate the rejection. Withdrawal of the rejection is respectfully requested.

Claims 1-14, 33-39 and 41

Claims 1-14, 33-39 and 41 have been rejected under 35 USC 102(e) as being anticipated by Adam et al. (US2002/0069164).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, the identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Regarding claim 1, Applicants respectfully disagree that Adam discloses each and every limitation of claim 1. For example, claim 1 requires storing in memory a transaction pattern reflecting a transaction, and executing the pattern to carry out the transaction. In sharp contrast, Adam paragraphs [0001-0003] merely indicate that a previously-generated bill of material is stored for later retrieval and editing by the user. Nowhere does Adam indicate that his bill of material, or anything relating thereto for that matter, is executable. Rather, the user is merely allowed to recall the bill of material for editing and resubmission. See Adam [0002], last sentence. This is clearly not the same as storing in memory a transaction pattern reflecting a transaction, and executing the pattern to carry out the transaction, as claimed. Therefore, the 35 USC 102(e) rejection of claim 1 is erroneous.

Nor can it be said that Adam suggests the limitations of claim 1. Adam does not teach or suggest executing a stored transaction pattern to carry out a transaction. Again, Adam is limited to recalling a previously-generated bill of material, which the user can then amend.

Reconsideration and allowance of claim 1 is respectfully requested.

Claims 2-14 depend from claim 1, and therefore incorporate the limitations of claim 1. By virtue of their dependence, claims 2-14 are also believed to be allowable.

Further regarding claims 2-3, Applicants respectfully disagree that Adam discloses each and every limitation of claim 2. For example, the rejection relies on Adam [0028] "identification information provided by the user" to disclose a record of user actions taken by the user. First, the "identification information provided by the user" relied on in the rejection appears more akin to information submitted by a user than actual user actions taken by the user. Thus, the cited section of Adam does not really disclose a transaction pattern that includes a record of user actions taken by a user at all. Second, in Adam [0028], the identification information is received from the user at the time the user wishes to recall a saved project. It does not appear that the "identification information provided by the user" relied on the in rejection is recorded at all, but rather is merely used to retrieve other data and discarded. Thus, this "identification information" cannot be part of a record in a transaction pattern (per claim 2) that is executed to carry out the transaction (per claim 1). Accordingly, the 35 USC 102(e) rejection of claim 2 is erroneous.

Regarding claim 7, claim 7 has been amended to require that the storage of the transaction pattern includes the storage of records of the navigation of a user during the transaction. In sharp contrast, the rejection of claim 7 indicates that Adam merely saves the results of a series of navigation steps, as opposed to the navigation itself, as now claimed. Reconsideration and allowance of claim 7 is respectfully requested.

Regarding claims 10-14, Applicants first note that the rejection refers to Adam disclosing execution of a transaction. However, what is claimed is execution of a transaction pattern. Accordingly, there appears to be an inherent defect in the logic of the rejections. For instance, the rejection of claim 13 relies on Adam [0001-0003], which merely indicates that users can recall a saved bill of material.

Regarding claim 10, the server of Adam's [0028] is cited as the automated or programmable agent. As mentioned above, Adam's bill of material or saved project is not an executable

transaction pattern, and so the server of [0028] does not retrieve a transaction pattern. Reconsideration and allowance of claim 10 is respectfully requested.

Regarding claim 12, Applicants respectfully disagree with the logic of the rejection. Particularly, the rejection indicates that, per Adam [0028], the presentment of a previously submitted bill of materials is an automatic navigation of the previous steps the user had to perform in order generate said bill of materials. Applicants disagree. Nowhere does Adam indicate that the steps the user had to perform in order generate said bill of materials are performed again, as stated in the rejection. There is simply no support for this contention in Adam. Accordingly, the rejection of claim 12 is erroneous. Reconsideration and allowance of claim 12 is respectfully requested.

Regarding claim 33, Applicants respectfully disagree that Adam discloses each and every limitation of claim 33. For example, claim 33 requires recording user actions taken by a user as part of a transaction. Adam [0003] is relied on in the rejection to show this feature, particularly, that Adam "records original submission of bill of materials for later use." However, this statement merely indicates that the results of user actions are recorded, not the user actions themselves, as claimed. Therefore, the 35 USC 102(e) rejection of claim 33 is erroneous.

Claims 34-39 depend from claim 33, and therefore incorporate the limitations of claim 33. By virtue of their dependence, claims 34-39 are also believed to be allowable.

Further, claim 34 contains limitations similar to claim 2, and so is also believed to be allowable for the similar reasons.

Claim 37 contains limitations similar to claim 10, and so is also believed to be allowable for the similar reasons.

Claim 38 contains limitations similar to claim 12, and so is also believed to be allowable for the similar reasons.

Regarding claim 41, Applicants respectfully disagree that Adam discloses each and every limitation of claim 41. For example, claim 1 requires storing in memory a transaction pattern reflecting a transaction, and executing the pattern to carry out the transaction. In sharp contrast, Adam paragraphs [0001-0003] merely indicates that a previously-generated bill of material is stored for later retrieval and editing by the user. Nowhere does Adam indicate that his bill of material is executable. Rather, the user is merely allowed to recall the bill of material for editing and resubmission. See Adam [0002], last sentence. This is clearly not the same as storing in memory a transaction pattern reflecting a transaction, and executing the pattern to carry out the transaction, as claimed. Therefore, the 35 USC 102(e) rejection of claim 41 is erroneous.

Claims 15-32, 40 and 42

Claims 15-32, 40 and 42 have been rejected under 35 USC 103(a) as being unpatentable over Adam.

The analysis of obviousness was set forth in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). In order to establish a *prima facie* case of obviousness, three basic criteria must be met:

> First, there must be some *suggestion or motivation*, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings of the references. Second, there must be a *reasonable expectation of success*. Finally, the prior art reference or combined references must teach or suggest *all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art*, and not based on applicant's disclosure (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991; emphasis added).

Applicants respectfully traverse the rejection as failing the *Graham* test. Specifically, the combination proposed in the rejection fails at least the third element of the *Graham* test.

Regarding claims 15, 30, 32, 40 and 42 the rejection fails at least the third element of the *Graham* test. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Claim 15 requires that the transaction pattern includes recognizing a state of a remote

application. Claims 30, 40 and 42 require that the execution of the transaction pattern includes recognizing a state of a remote application. In sharp contrast, Adam does not teach or suggest recognizing the state of a _remote_ application. Rather, all of Adam's executables appear to be local. The only mention of "remote" in the sections cited in the office action is in conjunction with retrieving specific data stored in a database remote from the server. However, this alone does not teach or suggest recognizing a state of a remote application; it is merely data retrieval. Thus, the limitations of claims 15, 30, 32, 40 and 42 are not taught or suggested by Adam. Because not all claim limitations are taught or suggested, the rejections of claims 15, 30, 32, 40 and 42 are improper as failing the third element of the *Graham* test.

Regarding claims 16-29, the claims have been rejected on the same art and rationale as claims 1-14. Accordingly, the rejection of claims 16-29 suffers from the same deficiencies as the rejection of claims 1-14. Particularly, Adam fails to teach each and every claim limitation, as set forth above in Applicants' arguments for claims 1-14. Accordingly, the rejection fails the third prong of the *Graham* test. Reconsideration and allowance of claims 1-14 is respectfully requested.

Claim 31 has been rejected on the same art and rationale as claim 1. Accordingly, the rejection of claim 31 suffers from the same deficiencies as the rejection of claim 1. Particularly, Adam fails to teach each and every claim limitation, as set forth above in Applicants' arguments for claim 1. Accordingly, the rejection fails the third prong of the *Graham* test. Reconsideration and allowance of claim 31 is respectfully requested.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. For payment of any additional fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1351 (Order No. NVIDP371).

Respectfully submitted,

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